

REMARKS / ARGUMENTS

The present application includes pending claims 1-30, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1, 2, 8-10, 11, 12, 18-20, 21, 22 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 5,915,221 ("Sawyer"), in view of USP 5,953,320 ("Williamson"). Claims 3-6, 13-16 and 23-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawyer and Williamson and further in view of USP 6,108,323 ("Gray"). Claims 7, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawyer, Williamson and Gray and further in view of USP 7,092,714 ("Noll"). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. EXAMINER'S RESPONSE TO ARGUMENTS

The Examiner states the following at pages 2-3 of the Final Office Action:

However, Examiner respectfully disagrees with Applicants' interpretation of Williamson. Examiner notes that Applicants are specifically speaking to the point in time after "by virtue of receiving the neighbor list message" to differentiate Williamson. As understood by the Examiner, Applicants is trying to say that "generates ... on its own ..." in the claim language means "generates from scratch" and not just a new neighbor list by replacement. In essence, a replacement or a new neighbor list is a "generates" too. Evidence of Applicants' true interpretation can be found in the amended Specification dated August 11, 2008. Para. [48.1],

discloses "AD 306 may dynamically keep a record ... of the frequency and corresponding signal strength of any received channel it encounters. Such record of frequencies and signal strengths may serve as a handoff candidate list." That is, the handoff candidate list is generated/created at the first encounter and is maintained/kept at subsequent encounters. If a point in time to define "generates" is important, such a limitation is not found in the claims.

3. Applicant's arguments do not comply with 37 CFR 1.111 (c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

4. Additionally, Examiner notes that the application of claims 1,11,21 is to an intermesh network using 802.11 protocol with PLCP. It is the exchange of PLCP that exists in 802.11 between the access point and the access device, inter-mesh as oppose to intra-mesh, that enables the access device to generate and maintain a handoff candidate list on its own. Such differentiations (inter-mesh, 802.11, PLCP) are just as important as the differentiation outlined above.

The Applicant respectfully disagrees with the above arguments. Initially, the relevant claim limitation from Applicant's claim 1 is "said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another access device." As previously stated (see e.g., 8/11/2008 response), support for the above claim limitation can be found not only at paragraph [48.1], as alleged above by the Examiner, but also at, for example, paragraphs [47]-[48] and both Figs. 3A-3B.

With regard to Williamson, the Examiner has not fully responded to Applicant's arguments appearing in pages 14-15 of the 9/14/2009 response. More specifically, the Applicant pointed out that Williamson's wireless device constructs the neighbor list after

being prompted by the base station by virtue of receiving the neighbor list message (step 200 in Fig. 2A). Only then, the wireless device builds the active neighbor list from the received neighbor list message (step 202 in Fig. 2A). Therefore, Williamson does not generate a handoff candidate list ... "without being prompted to do so by another access device." In this regard, the issue is not whether or not Applicant's claim 1 defines a point in time when the "generates" functionality takes place. The issue is whether or not Williamson overcomes the deficiency of Sawyer by disclosing an access device that generates and maintains a handoff candidate list on its own and without being prompted to do so by another access device. Williamson does not overcome this deficiency.

The Applicant maintains that the above arguments, as well as the arguments in the 9/14/2009 response, clearly point out the patentable novelty of claim 1, as well as differentiate both Sawyer and Williamson by explaining their corresponding deficiencies. Furthermore, in reference to Examiner's statement (4) above, the Applicant points out that the differentiation between intra- and inter-mesh network is irrelevant for purposes of overcoming the references presented by the Examiner. As already explained, Sawyer and Williamson (taken separately or in combination) are deficient and do not render Applicant's claim 1 unpatentable for at least the above reasons.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Sawyer and Williamson Does Not Render Claims 1, 2, 8-10, 11, 12, 18-20, 21, 22 and 28-30 Unpatentable

A. Independent Claims 1, 11 and 21

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Sawyer and Williamson does not disclose or suggest at least the limitation of “said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another access device,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

With regard to claim 1, Sawyer discloses

coupling a first wireless access point (B1-B10 in Fig. 1, col. 5, line 15) located in a first cell of the mesh network (Cell A-Cell J in Fig. 1, col. 5, line 13) to at least a second wireless access point (B1-B10 in Fig. 1, col. 5, line 15) located in a second cell of the mesh network (Cell A-Cell J in Fig. 1, col. 5, line 13);

providing service initially to at least one of a plurality of access devices (M1-M10 in Fig. 1, col. 1, line 31) in the mesh network by said first wireless access point located in said first cell (“a plurality of mobile stations M1-M10 may be found within Cell A-Cell J”, col. 5, lines 30-31); and

serving within the mesh network, said at least one of a plurality of access devices by said at least a second wireless access point located in said second cell (mobile assisted handoff, col. 6, lines 60-61), wherein whenever a signal for said at least one of a plurality of access devices falls below a specified threshold (handoff criteria, col. 7, line 28), said at least a second wireless access point is selected from said handoff candidate list (neighbor cell list, col. 7, line 11).

However, Sawyer fails to explicitly show said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another access device.

In an analogous art of handoff with neighboring list, Williamson discloses said at least one of said plurality of access devices generates ("In response to the received Neighbor List Message ... , the mobile station builds the active neighbor list table at block 202", col. 7, lines 38-41) and maintains (" ... the mobile station begins the construction of a temporary neighbor list by replacing the record ... in the existing neighbor list (the neighbor list build in block 202), col. 8, lines 8-12) a handoff candidate list on its own without being prompted to do so by another access device.

See Final Office Action at pages 2-4. The Examiner, in the above citation, concedes that Sawyer does not disclose that at least one of a plurality of access devices generates and maintains a handoff candidate list on its own without being prompted to do so by another access device. The Examiner then relies for support on col. 7, lines 38-41 of Williamson.

Williamson discloses that a wireless communication device receives a neighbor list message from a first base station, where the neighbor list message includes a respective base station configuration parameter for each of a plurality of base stations. In response to the neighbor list message, the wireless communication device constructs a neighbor list table, including one record for each of the plurality of base stations, with each record including their respective base station configuration parameter. After handing off to a second base station, the wireless communication device replaces the record for the second base station with a corresponding record for the first base station. See Williamson at Abstract and Fig. 2A. In this regard, **Williamson's wireless device constructs the neighbor list after being prompted by the base station by virtue of receiving the neighbor list message (step 200 in Fig. 2A). Only then, the wireless**

device builds the active neighbor list from the received neighbor list message (step 202 in Fig. 2A).

Therefore, Williamson does not disclose “said at least one of said plurality of access devices generates and maintains a handoff candidate list on its own **without being prompted to do so by another access device**,” as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Sawyer and Williamson does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2, 8-10, 12, 18-20, 22 and 28-30

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Sawyer in view of Williamson has been overcome and requests that the rejection be withdrawn. Additionally, claims 2, 8-10, 12, 18-20, 22 and 28-30 depend from

independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 8-10, 12, 18-20, 22 and 28-30.

III. The Proposed Combination of Sawyer, Williamson and Gray Does Not Render Claims 3-6, 13-16 and 23-26 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being anticipated by Sawyer and Williamson has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Gray) does not overcome the deficiencies of Sawyer, claims 3-6, 13-16 and 23-26 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-6, 13-16 and 23-26.

IV. The Proposed Combination of Sawyer, Williamson, Gray and Noll Does Not Render Claims 7, 17 and 27 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being anticipated by

Sawyer and Williamson has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Noll) does not overcome the deficiencies of Sawyer, claims 7, 17 and 27 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 7, 17 and 27.

In general, the Final Office Action makes various statements regarding claims 1-30 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-30 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 11-FEB-2010

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